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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,959	05/24/2001	Hiroyuki Watanabe	S004-4306	2869

7590 11/30/2005
ADAMS & WILKS
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New York, NY 10004

EXAMINER

NGUYEN, TRI V

ART UNIT PAPER NUMBER

3622

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/864,959

Applicant(s)

WATANABE ET AL.

Examiner

Tri V. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 May 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 May 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because of undue length (163 words). The applicant is reminded that the length of the abstract is 150 words or less. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 7-9, 11-14, 17-22 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Fajkowski (WO 98/19229).

Regarding Claim 1, Fajkowski discloses an electronic coupon issuing system configured to enable use and redemption of issued electronic coupons that are in electronic or printed form, the electronic coupon issuing system comprising:

- a. an electronic coupon server having a database for storing a plurality of electronic coupons and for storing information regarding requests for acquisition of the electronic coupons including IDs of redemption media used for redemption of the electronic coupons, the redemption media being presented by consumers at the point of sale when the electronic coupons are redeemed, and search means for receiving the IDs of the redemption media and searching the server database for electronic coupons that are useable in connection with the IDs (page 6, lines 13-23 and page 14, line 29 to page 15, line 14); and

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b. an electronic coupon redemption terminal for receiving the redemption media at the point of purchase, inquiring with the electronic coupon search means of the electronic coupon server whether an electronic coupon exists for a given purchase, and approving the use of useable electronic coupons (page 5, line 13 to page 6, line 12 and page 13, line 17 to page 14, line 9);

c. wherein the electronic coupon server receives a request for acquisition of an electronic coupon from an electronic coupon registration terminal and stores the ID of the redemption media in correlation with the electronic coupon (page 6, lines 13-23 and page 13, line 17 to page 14, line 9); and

d. the electronic coupon search means receives the ID of the redemption media and information regarding the intended use from the electronic coupon redemption terminal, performs a search to determine whether or not an electronic coupon useable for the ID of the redemption media and for the intended use exists, and sends results of the search to the electronic coupon redemption terminal (page 5, line 13 to page 6, line 12; page 22, line 14 to page 23, line 6; page 25, line 22 to page 26, line 5 and Fig 12).

Regarding Claim 2, Fajkowski discloses an electronic coupon issuing system according to claim 1; wherein the electronic coupon server accumulates the search results of searches performed by the electronic coupon search means and accumulates electronic coupon usage information (page 13, lines 17-30; page 29, line 21 to page 30, line 14 and page 31, line 6 to page 33, line 6).

Regarding Claim 3, Fajkowski discloses an electronic coupon issuing system according to claim 1; wherein the electronic coupon registration terminal is at least one of a mobile telephone, a computer connected to a network, or a digital broadcast reception terminal (page 39, line 26 to page 41, line 17).

Regarding Claim 4, Fajkowski discloses an electronic coupon issuing system according to claim 1; wherein the electronic coupons are at least one of coupons for discounts, benefits, or tickets (page 6, lines 24-28 and Figs 11-12).

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Regarding Claim 7, Fajkowski discloses an electronic coupon issuing system according to claim 1; wherein the electronic coupon redemption media include at least one of credit cards, debit cards, point-accumulation cards, or mileage accumulation cards (page 37, line 19 to page 38, line 18).

Regarding Claim 8, Fajkowski discloses an electronic coupon issuing system according to claim 7; wherein the electronic coupon redemption media comprises credit cards, the electronic coupon redemption terminal serves as a credit card authorization terminal, and the electronic coupon redemption terminal is connected to the electronic coupon server via a credit card settlement center or via a relay center for relaying information to a credit card payment authorization center (page 28, line 21 to page 29, line 14 and page 37, line 19 to page 38, line 18).

Regarding Claim 9, Fajkowski discloses an electronic coupon issuing system according to claim 8; wherein the electronic coupon redemption terminal simultaneously dispatches a search for the electronic coupon and a request for approval for a credit card purchase authorization, and when the electronic coupon is useable for a discount, the electronic coupon redemption terminal sends out a second request for a credit card purchase authorization at a discounted price indicated by the electronic coupon (page 28, line 21 to page 29, line 14 and page 37, line 19 to page 38, line 18).

Regarding Claim 11, Fajkowski discloses an electronic coupon issuing method configured to enable redemption of electronic or printed coupons, the method comprising the steps of:

- a. storing a plurality of coupons (page 14, line 29 to page 15, line 14);
- b. receiving a request for acquisition of an electronic coupon and storing electronic coupon acquisition information in association with ID information of an electronic coupon redemption medium to be used at the point of sale for redemption of the electronic coupon (page 13, line 17 to page 14, line 9); and
- c. upon receipt of the electronic coupon redemption medium, performing a search of the stored electronic coupons to determine whether there exists an electronic coupon

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that is usable with the electronic coupon redemption medium, and approving use of the electronic coupon redemption medium when a usable electronic coupon exists (page 22, line 14 to page 23, line 6; page 25, line 22 to page 26, line 5 and Fig 12).

Regarding Claim 12, Fajkowski discloses an electronic coupon issuing method according to claim 11; further comprising the step of accumulating electronic coupon usage information (page 13, lines 17-30; page 29, line 21 to page 30, line 14 and page 31, line 6 to page 33, line 6).

Regarding Claim 13, Fajkowski discloses an electronic coupon issuing method as claimed in claim 11; further comprising the step of requesting an electronic coupon by use of a mobile telephone or a computer which is connected to a network, or by a digital broadcast reception terminal (page 39, line 26 to page 41, line 17).

Regarding Claim 14, Fajkowski discloses an electronic coupon issuing method as claimed in claim 11; wherein the electronic coupons are coupons for discounts, benefits or tickets (page 6, lines 24-28 and Figs 11-12).

Regarding Claim 17, Fajkowski discloses an electronic coupon issuing method according to claim 11; wherein the electronic coupon redemption medium is at least one of a credit card, a debit card, a point accumulation card, or a mileage accumulation card (page 37, line 19 to page 38, line 18).

Regarding Claim 18, Fajkowski discloses an electronic coupon issuing method according to claim 17; wherein the electronic coupon redemption medium is a credit card; and further comprising the step of using a credit card authorization terminal for performing redemption of the electronic coupon (page 28, line 21 to page 29, line 14 and page 37, line 19 to page 38, line 18).

Regarding Claim 19, Fajkowski discloses an electronic coupon issuing method according to claim 18; further comprising the step of performing credit card purchase authorization using the credit card authorization terminal, and the step of performing

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credit card authorization is performed at a discounted price when an electronic coupon for the discounted price is usable (page 28, line 21 to page 29, line 14 and page 37, line 19 to page 38, line 18).

Regarding Claim 20, Fajkowski discloses an electronic coupon issuing system for issuing coupons in electronic form, the coupons being redeemable at the point of purchase without the need to present a printed copy thereof, the system comprising:

a. an electronic coupon server having a memory for storing a database of available electronic coupons along with identifying indicia of redemption media to be used at the point of purchase to redeem coupons, and search means for receiving the identifying indicia of the redemption media and searching the database for electronic coupons that are useable in connection with the identifying indicia (page 6, lines 13-23 and page 14, line 29 to page 15, line 14) ; and

b. an electronic coupon redemption device for receiving the redemption media and communicating with the search means of the electronic coupon server to determine whether an electronic coupon exists and has been associated with the identifying indicia of the redemption media (page 5, line13 to page 6, line 12 and page 13, line 17 to page 14, line 9);

c. wherein the electronic coupon server receives a request for acquisition of an electronic coupon from an electronic coupon registration terminal along with the identifying indicia of and stores the request the redemption media (page 5, line13 to page 6, line 12 and page 13, line 17 to page 14, line 9);

d. wherein the search means receives the identifying indicia of the redemption media and information regarding the intended use from the reception terminal, performs a search to determine whether or not an electronic coupon useable for the identifying indicia and for the intended use exists, and sends the search results to the electronic coupon redemption device (page 5, line13 to page 6, line 12; page 22, line 14 to page 23, line 6; page 25, line 22 to page 26, line 5 and Fig 12).

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Regarding Claim 21, Fajkowski discloses an electronic coupon issuing system according to claim 20; wherein the electronic coupon server accumulates the results of searches performed by the search means and accumulates electronic coupon usage information (page 13, lines 17-30; page 29, line 21 to page 30, line 14 and page 31, line 6 to page 33, line 6).

Regarding Claim 22, Fajkowski discloses an electronic coupon issuing system according to claim 20; wherein the electronic coupon registration terminal comprises one or more of a mobile telephone, a computer connected to a network, or a digital broadcast reception terminal (page 39, line 26 to page 41, line 17).

Regarding Claim 25, Fajkowski discloses an electronic coupon issuing system according to claim 20; wherein the redemption media includes at least one of credit cards, debit cards, point-accumulation cards, and mileage accumulation cards (page 37, line 19 to page 38, line 18).

Regarding Claim 26, Fajkowski discloses an electronic coupon issuing system according to claim 25; wherein the redemption media comprises credit cards, the electronic coupon redemption device serves as a credit card purchase authorization terminal, and the electronic coupon redemption device is connected to the electronic coupon server via a credit card settlement center or via a relay center for relaying information to a credit card payment authorization center (page 37, line 19 to page 38, line 18).

Regarding Claim 27, Fajkowski discloses an electronic coupon issuing system according to claim 26; wherein the electronic coupon redemption terminal simultaneously dispatches a search for the electronic coupon and a request for approval for a credit card purchase, and when the electronic coupon is useable for a discount, the electronic coupon redemption terminal sends out a second request for a credit card purchase authorization at a discounted price indicated by the electronic coupon (page 37, line 19 to page 38, line 18).

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- EWS*
5. Claims ^{5, 6, 15, 16, 23, AND 24}~~5, 15~~ and are rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski in view of Counts (5,192,854).

Regarding Claims 5 and 6, Fajkowski discloses an electronic coupon issuing system according to claim 1 but does not explicitly teach wherein the electronic coupon redemption terminal prints out the electronic coupon. Fajkowski discloses the use of paper coupon at the redemption terminal in lieu of an electronic coupon (page 24, line 20 to page 25, line 9). In an analogous art, Counts discloses a system for electronically redeeming coupons with an option to print out a paper coupon (page 5, lines 42-51 and page 6, lines 22-35) of the display of bar code coupon (Elements 102-108 of Fig 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Fajkowski. One would have been motivated to use a print out of the electronic coupon to allow for a greater choice of accessible points-of-sale (POS) such as cash POS.

Claims 15 and 16 describe the method of claims 5 and 6 respectively; therefore, the prior arts of Fajkoswki and Counts as set forth above in claims 5 and 6 are relied upon to reject claims 15 and 16.

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Claims 23 and 24 describe the system of claims 5 and 6 respectively; therefore, the prior arts of Fajkoswki and Counts as set forth above in claims 5 and 6 are relied upon to reject claims 23 and 24.

6. Claims 10 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski in view of Walker et al. (6,694,300).

Regarding Claim 10, Fajkowski discloses an electronic coupon issuing system according to claim 8 but does not explicitly teaches wherein the electronic coupon redemption terminal and the credit card settlement center or the relay center which relays information to the credit card payment authorization center are connected wirelessly. In an analogous art, Walker et al. teaches the use of a POS terminal that is wirelessly connected to the central controller operated by a credit card clearing house (col 3, lines 45-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Fajkowski. One would have been motivated to use a wireless connection to allow for a more mobile POS, a more flexibility in interior design and better customer services.

Claim 28 describes the system of claim 10 respectively; therefore, the prior arts of Fajkoswki and Walker et al. as set forth above in claim 10 are relied upon to reject claims 23 and 24.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


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- A. Palmer et al. (6,505,773) discloses an electronic coupon issuing and redemption system wherein the coupons are issued on a smart card and electronic reimbursements are issued at the redemption station.
 - B. Bandera et al. (6,332,127) discloses a method for selecting an advertising object to be displayed within a Web page and for redeeming an electronic coupon within a designated geographic region.
 - C. Christensen et al. (5,710,886) discloses a method for distributing, generating and redeeming electric coupons using a consumer ID in the form of a bar code printed on the coupon.
 - D. Valencia et al. (5,380,991) discloses a paperless coupon redemption method employing a smart card.
 - E. Nichtberger et al. (4,882,675) discloses a paperless system for distributing, redeeming and clearing coupons using card that is immediately credited at the store.
 - F. Golden et al. (2002/0178051 A1) discloses a system issuing electronic coupons through online networks that can be printed out.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:30 AM to 5 PM.
- If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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